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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,144	04/07/2004	H. Thomas Graef	D-1238 R2	8941
28995	7590	07/24/2006		
RALPH E. JOCKE			EXAMINER	
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MEDINA, OH 44256			ART UNIT	PAPER NUMBER
				3651

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/821,144	GRAEF ET AL.
	Examiner Leslie A. Nicholson III	Art Unit 3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 July 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 2,4 and 25 is/are allowed.
- 6) Claim(s) 1,3,5-24,26-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 April 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Response to Arguments and Amendments***

1. Applicant's arguments filed 7/6/2006 have been fully considered but they are not persuasive.

Regarding the indefiniteness of claims 1,3,5-24,26-28, Applicant has failed to explain how the at least one additional note moves relative to the first note while both notes are moving in the second direction. Claims 2,4, and 25 recite how there is relative movement between the two notes, i.e.: claim 2 recites the at least one additional note moving in the second direction *more rapidly* than the first note (emphasis included). In this instance, the relative movement is clearly defined. In the instance of claim 1, for example, reciting two notes moving in the same direction relative to one another renders the claim unclear. If they are moving in the same direction, how is the movement relative?

Regarding claim 27, the previous matter indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims is hereby withdrawn. Upon further review, it appears as though Graef (US 4,494,747) discloses all the limitations of the claim and element (c), as best understood by the Examiner (see above and ¶3) as it apparent from at least C12/L2-27 and Applicant's arguments (filed 7/6/2006) that the first note and extra note are moved together as a unit toward the stack when an extra note is detected and that the picked note moves in the first direction such that the picked note is separated from the

overlying note by the at least one stripper member (44) (C12/L21-24). The claims do not recite the stripper member rotating in the reverse direction, but only that the stripper member is in engagement with an overlying note when the overlying note moves in the second direction (claim 27).

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1,3,5-24,26-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

See ¶1.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,3,5,6,24,26,27, as best understood by the examiner (see ¶3), are rejected under 35 U.S.C. 102(b) as being anticipated by Graef USP 4,494,747.

Graef discloses a similar method comprising:

- a) picking a first note bounding a stack of notes (11A), from the stack with at least one picking member (28) engaged with the first note, wherein the picking causes the first note to move in a first direction toward at least one stripper member (C10/L60-65)
- b) engaging notes other than the first note with the at least one stripper member (44,47), wherein generally notes other than the first note are prevented from moving from the stack
- c) sensing with at least one sensor (48) before the first note has disengaged from the stack, that at least one additional note has moved with the first note from the stack past the at least one stripper member (44,47) (C9/L13-17)
- d) responsive to (c), moving the first note in a second direction opposed of the first direction while engaged with the at least one picking member, and moving the at least one additional note in the second direction relative to the first note while the first note moves in the second direction (C12/L3-13)
- e) moving the first note in the first direction such that the first note is separated from the at least one additional note by the at least one stripper member (C8/L8-20, C12/L2-27)

Graef further discloses a similar method wherein (a) includes urging the first note to move in the first direction by moving at least one moving member that is in supporting connection with the stack (C7/L46-62) and wherein (d) includes urging the first note to move in the second direction through moving the at least one moving member in the second direction (C4/L59-62).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-10,14-17,18,19,20-23, as best understood by the examiner (see ¶3), are rejected under 35 U.S.C. 103(a) as being unpatentable over Graef USP 4,494,747 in view of Beskitt USP 6,302,393.

Graef discloses all the limitations of the claim, but does not expressly disclose determining if each first note moved from the stack has at least one characteristic associated with a valid note through operation of at least one validator device, moving notes determined to have the at least one characteristic of validity in (e), toward at least one first storage location, moving sheets determined as not having the at least one characteristic of validity in (e), toward at least one second storage location, the at least one second storage location is included in a module with the at least one validator, receiving the stack of notes in a chute, wherein the module includes the chute, and prior to receiving the stack of notes in the chute, further comprising opening a gate bounding the chute wherein opening the gate enables the chute to receive the stack of notes.

Beskitt teaches a similar method further comprising (e) determining if each first note moved from the stack has at least one characteristic associated with a valid note through operation of at least one validator device (38) (C6/L21-31), (f) moving notes

determined to have the at least one characteristic of validity in (e), toward at least one first storage location (68) (C6/L32-59), (g) moving sheets determined as not having the at least one characteristic of validity in (e), toward at least one second storage location (70) (C6/L59-67), and wherein in (g) the at least one second storage location is included in a module (10) with the at least one validator (fig. 1) for the purpose of determining the particular type of sheet or note which is passed and separating valid sheets from counterfeit sheets (C6/L21-67).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the steps of determining if each first note moved from the stack has at least one characteristic associated with a valid note through operation of at least one validator device, moving notes determined to have the at least one characteristic of validity, toward at least one first storage location, moving sheets determined as not having the at least one characteristic of validity, toward at least one second storage location, and wherein the at least one second storage location is included in a module with the at least one validator, as taught by Beskitt, in the method of Graef, for the purpose of determining the particular type of sheet or note which is passed and separating valid sheets from counterfeit sheets.

Regarding claims 14-17, Graef discloses all the limitations of the claim, but does not expressly disclose the method wherein (b) includes engaging notes other than the first note with at least one contact stripper member and at least one non-contact stripper member, the at least one contact stripper member biasingly engages the at least one picking member when no note extends therebetween, the at least one non-contact

stripping member is disposed from the at least one picking member, or wherein the picking member includes an annular recess, and wherein the at least one non-contact stripper member extends in the at least one annular recess, and wherein a cross sectional wave configuration is imparted to the first note.

Beskitt teaches a similar method wherein (b) includes engaging notes other than the first note with at least one contact stripper member (194) and at least one non-contact stripper member (194') (C15/L65-67, fig.14,15), the at least one contact stripper member biasingly engages the at least one picking member (190) when no note extends therebetween (fig.15) (C13/L50-54), the at least one non-contact stripping member is disposed from the at least one picking member, wherein the picking member includes an annular recess, and wherein the at least one non-contact stripper member extends in the at least one annular recess (fig.15), and wherein in (b) a cross sectional wave configuration is imparted to the first note for the purpose of facilitating the outermost sheet from the other sheets in the stack (C13/L54-56).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the steps of engaging notes other than the first note with at least one contact stripper member and at least one non-contact stripper member, the at least one contact stripper member biasingly engages the at least one picking member when no note extends therebetween, the at least one non-contact stripping member is disposed from the at least one picking member, wherein the picking member includes an annular recess, and wherein the at least one non-contact stripper member extends in the at least one annular recess, and wherein a cross sectional wave configuration is imparted

to the first note, as taught by Beskitt, in the method of Graef, for the purpose of facilitating the outermost sheet from the other sheets in the stack.

Regarding claims 18 and 19, Graef discloses all the limitations of the claim, but does not expressly disclose prior to (a) further comprising receiving the stack of notes in a chute, wherein the module includes the chute, or prior to receiving the stack of notes in the chute, further comprising opening a gate bounding the chute wherein opening the gate enables the chute to receive the stack of notes.

Beskitt teaches a similar method prior to (a) further comprising receiving the stack of notes in a chute (28), wherein the module includes the chute and prior to receiving the stack of notes in the chute, further comprising opening a gate bounding the chute wherein opening the gate enables the chute to receive the stack of notes (fig.1) for the purpose of allowing the customer to insert and receive sheets (C5/L46-52).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the steps of receiving the stack of notes in a chute, wherein the module includes the chute and prior to receiving the stack of notes in the chute, further comprising opening a gate bounding the chute wherein opening the gate enables the chute to receive the stack of notes, as taught by Beskitt, in the method of Graef, for the purpose of allowing the customer to insert and receive sheets (C5/L46-52).

Regarding claims 20-23, Graef discloses all the limitations of the claim, but does not expressly disclose the method prior to (a) further comprising receiving at least one input from a user through at least one input device of an automated banking machine,

wherein the at least one input is operative to identify at least one of the user and an account, receiving the stack of notes into the machine from the user, and wherein in (a) the first note is moved from the stack within the machine, determining whether each first note moved from the stack is a valid note through operation of at least one note validator device and crediting at least one of the user and the account a value associated with notes determined as having the at least one characteristic of validity in (e) or subsequent to (d), moving the first note in the first direction separately from another note.

Beskitt teaches a similar method and prior to (a) further comprising receiving at least one input from a user through at least one input device of an automated banking machine, wherein the at least one input is operative to identify at least one of the user and an account (C5/L1-6), receiving the stack of notes into the machine from the user, and wherein in (a) the first note is moved from the stack within the machine (C5/L45-63, C6/L20-31), determining whether each first note moved from the stack is a valid note through operation of at least one note validator device and crediting at least one of the user and the account a value associated with notes determined as having the at least one characteristic of validity in (e) (C4/L66-67, C5/L1-6, C6/L20-30), and subsequent to (d), moving the first note in the first direction separately from another note (C14/L22-41) for the purpose of allowing a customer to make valid transactions.

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the steps of receiving at least one input from a user through at least one input device of an automated banking machine, wherein the at least one input is

operative to identify at least one of the user and an account, receiving the stack of notes into the machine from the user, and wherein in (a) the first note is moved from the stack within the machine, determining whether each first note moved from the stack is a valid note through operation of at least one note validator device and crediting at least one of the user and the account a value associated with notes determined as having the at least one characteristic of validity in (e), and subsequent to (d), moving the first note in the first direction separately from another note, as taught by Beskitt, in the method of Graef, for the purpose of allowing a customer to make valid transactions.

Regarding claim 22, Graef discloses all the limitations of the claim, but does not expressly disclose the method step of storing data in at least one data store correlating the user with notes not determined as valid (e).

Beskitt teaches the method of storing data in at least one data store correlating the user with notes not determined as valid (e) for the purpose of determining whether or not the customer is authorized to operate the machine (C7/L56-65).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the method of storing data in at least one data store correlating the user with notes not determined as valid (e), as taught by Beskitt, in the method of Graef, for the purpose of determining whether or not the customer is authorized to operate the machine.

8. Claims 11-13, as best understood by the examiner (see ¶3), are rejected under 35 U.S.C. 103(a) as being unpatentable over Graef USP 4,494,747 in view of Beskitt USP 6,302,393 further in view of Peters USP 5,267,826.

Regarding claim 11 and 12, Graef discloses all the limitations of the claim, but does not expressly disclose the method further comprising (h) dispensing notes from the automated banking machine, wherein the dispensing notes are removed from the at least one storage location but does not expressly disclose the storage location within a chest portion

Peters teaches the storage location (102) within a chest portion (188) of an automated banking machine (fig.5) for the purpose of preventing unauthorized access to the at least one storage location.

At the time of invention it would have been obvious to one having ordinary skill in the art to locate at least one first storage location within a chest portion of an automated banking machine, as taught by Peters, in the method of Beskitt, for the purpose of preventing unauthorized access to the at least one storage location.

Regarding claim 13, Graef discloses all the limitations of the claim, but does not expressly disclose the method wherein the notes dispensed in (h) include notes previously determined as having the at least one characteristic of validity in (e).

Beskitt teaches a similar method wherein the notes dispensed in (h) include notes previously determined as having the at least one characteristic of validity in (e) for the purpose of determining the particular type of sheet or note which is passed and separating valid sheets from counterfeit sheets (C6/L21-53).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the step wherein the notes dispensed include notes previously determined as having the at least one characteristic of validity, as taught by Beskitt, in the method of Graef, for the purpose of determining the particular type of sheet or note which is passed and separating valid sheets from counterfeit sheets.

***Allowable Subject Matter***

9. Claims 2,4,25 are allowed.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Nicholson III whose telephone number is 571-272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

L.N.  
7/17/2006



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